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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,407	11/14/2003	Robert J. Dunki-Jacobs	END-5005NP	9912

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EXAMINER	
JUNG, WILLIAM C	
ART UNIT	**PAPER NUMBER**
3737	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,407	DUNKI-JACOBS ET AL.	
	Examiner	Art Unit	
	William Jung	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20122005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 15, 2005 have been fully considered but they are not persuasive.

After further consideration of the applicant's remarks, examiner respectfully disagrees.

In regards to claims 1 and 2, the applicant argues that the office action dated June 30th 2005 does not appear to address the specific method steps set forth in pending claims. Examiner would like to point out that Kovacs et al specifically teach use of labeling target tissue or region by introducing chemicals such as dye-based chemicals, which are excited by optical emitter to induce fluorescence. Since the optical properties of the dye-based agent and normal tissue emit different fluorescence wavelength the tissue differentiation can be made. The purpose of using these dye-based agents is to increase contrast and detection of the region of interest. In addition, Kovacs et al specifically disclose in figure 12 where the biosensor transponder is guided through the body cavity such as GI (col. 18, lines 15-23). Furthermore, the claimed invention in claims 1 and 2 do not specify the steps of administering a marking material to a patient. The mere statement of administering the marking materials is no different than Kovacs et al's use of dye-based agent to a patient to enhance bionsensor transponder detection of the region of interest.

I n regards to claim 3, the only difference between Iddan et al and Kovacs et al is that Kovacs et al teach transponder on a catheter insertable to a body cavity. Iddan et al teach that biosensor transponder such as Kovacs et al do not necessarily require catheter, i.e. the transponder can be a capsule that is entirely swallowable and guided through the GI.

Therefore, examiner maintains the previous rejection and repeated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, and 4-15 are rejected under 35 U.S.C. 102(b) as being anticipated by ***Kovacs et al*** (US 5,833,603).

Kovacs et al anticipate all claimed features in claims 1 and 2. Kovacs et al disclose a system and method for detecting tissues comprising a capsule comprising a detector, a substance for associating with a target tissue where the substance is capable of being detected by the detector and a machine for verifying at least one of the detector and substance are suitable for use (col. 3, line 10 – col. 4, line 59; col. 6, lines 8-56). Kovacs et al further disclose the steps of verifying at least one component and concentration (amount of chemical or biochemical substance) of the physical properties of the tissue, cell, and biochemical components of region of interest. Although, Kovacs et al do not explicitly state that the detection substance is a monoclonal body, peptide, nanoparticle, mRNA and DNS corresponding to a generic monoclonal antibody, and liposome, these are inherent properties of biochemical composition of the tissues and cells (col. 6, lines 26-36). In addition, Kovacs et al disclose that the biosensor detects energy spectra via optical or photosensor, which is used along with dye to acquire optical radiation. Although Kovacs et al do not explicitly state use or radioisotopes, the dye solution with radiation optical acquisition is inherent that the dye solution must be radioactive or radioisotopes (col. 1, lines 56-65; col. 4, lines 34-44; col. 5, lines 5-26). Furthermore, Kovacs et

al disclose the method above where the sensor is a spectrophotometer acquiring multiple images of data from a region of interest with predetermines spectrum , wavelengths, and position to detect optical spectrum, i.e. spatial response pattern (col. 1,line 66 – col. 2, line 11).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over ***Kovacs et al*** as in view of ***Iddan et al*** (US 5,604,531).

Kovacs et al substantially anticipate all claimed features in claim 3. Kovacs et al disclose a system for detecting tissues comprising a capsule comprising a detector, a substance for associating with a target tissue where the substance is capable of being detected by the detector and a machine for verifying at least one of the detector and substance are suitable for use (col. 3, line 10 – col. 4, line 59; col. 6, lines 8-56). In addition, Kovacs et al disclose that the capsule includes multiple detectors, a radiation detector, magnetic detector, and single analyzer for each detector (col. 4, lines 35-44). Although Kovacs et al disclose implantation of the sensor device, Kovacs et al do not disclose that the capsule is a swallowable or that the capsule material is coated to allow the capsule to goes through the gastro-intestinal (GI) tract. However, Kovacs et al's deficiency is well known in the art where Iddan et al teaches a similar capsule detector where the device is swallowable and coated with material to allow the detector to pass through the GI tract (col. 1, lines 34-40; col. 3, line 8 – col. 5, line 6). Therefore, it would have been

obvious to one having an ordinary skill in the art at the time the invention was made to apply Kovacs et al's teachings as described above with Iddan et al's device designed to be swallow through the GI tract to achieve the claimed invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 571-272-4739. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AJC
March 1, 2006

BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
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